

## **REMARKS**

The Office Action mailed October 12, 2007 has been carefully considered. Within the Office Action Claims 1-53 and 55 have been rejected.

### **Rejections Pursuant to 35 U.S.C. § 112, first paragraph**

In the Office action claim 2, 16, 30, and 42 were rejected as allegedly failing to comply with the written description requirement. Claims 2, 16, 30 and 42 have been amended such that the speaker is in the first body. Withdrawal of the rejection is respectfully requested.

### **Rejection under U.S.C. § 103**

Claims 1-3, 10, 12-14, 16, 23, 25-27, 29-31, 36, 38-39, 41-43, 50 and 52-53 were rejected as being allegedly obvious over United States Pat No. 5,337,346 to Uchikura in view of United States Pat No. 7,130,669 to Moon and further in view of JP 2002-359666 (JP reference). The rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims in issue; resolving the level of

ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int’l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) (“ Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**”) (emphasis added).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

Applicant’s specification describes an embodiment in which the mobile device includes gaming controls in the recess of the first portion as well as on the facing side of the second portion of the third body. In particular to example embodiments shown in Figures 2B and 2C, Applicants describe that dedicated gaming controls, which are controls which are used only for gaming, are incorporated into the device to allow the user to be involved in a richer gaming experience.

Although keyboard controls may be used as gaming controls, as pointed out by the Examiner in U.S. Patent No. 6,825,832 to Chung, using a keyboard for gaming has several disadvantages. A full keyboard typically has more keys than are needed to play a video game (which typically uses 5-10 separate keys). Thus, a user playing a game with a full keyboard on a mobile device may have trouble finding the necessary keys to successfully play the game when more keys are provided than are needed. In contrast, a dedicated set of gaming controls is advantageous since the user will not have to fumble around and hunt for which keys to press to play the game. Furthermore, a mobile device with the dedicated gaming controls will allow the user to feel more like he or she is playing on a full console gaming unit.

Claim 1 has been amended to recite *inter alia*,

a second body having opposed ends, a recess disposed between, and spaced-apart from, said opposed ends, with a first portion **of said second body including at least a game pad having one or more dedicated game pad controls thereon** disposed within said recess; and

a third body including a number pad and pivotally attached to move to an open position with respect to said second body to reveal said first portion and a second portion of said **game pad, said second portion including one or more dedicated game pad controls therein, wherein at least one of said dedicated game pad controls of the second portion is different than at least one of said dedicated game pad controls of the first portion**, with said first body being pivotally attached to move with respect to said second body to reveal said display screen and said number pad when in a closed position.

(emphasis added). Claim 16 has been amended to recite *inter alia*,

a second body having opposed ends, a recess disposed between, and spaced-apart from, said opposed ends, with a first portion **of said second body including at least a game pad having one or more dedicated game pad controls thereon** disposed within said recess;

a third body having opposed sides and a number pad, said third body being pivotally attached to move with respect to said second body to reveal said first portion said **game pad only when in an open position**, with said second portion being disposed on one of said opposed sides and said number pad being disposed upon the remaining side of said opposed sides when in a closed position;

(emphasis added). Claim 29 has been amended to recite *inter alia*,

a second body having opposed ends, a recess disposed between, and spaced-apart from, said opposed ends, with a first portion of a user interface disposed within said recess **said user interface having only dedicated game pad controls**; and

a third body including a number pad and a second portion of said user interface, wherein **said second portion includes additional dedicated game pad controls**, with said first and second portions being completely covered when said third body is in a closed position, wherein said third body pivots with respect to said second body about one hinge axis to an open position to reveal said first and second portions **to allow only game play using said dedicated controls**.

(emphasis added). Claim 41 has been amended to recite *inter alia*,

a second body having opposed ends, with a recess formed between said opposed ends and a first input interface disposed within said recess thereon, said **first input interface including only dedicated game pad controls**, said second body being pivotally coupled to said first body to rotate about a first hinge axis to reveal said display screen; and

a third body pivotally coupled to said second body to pivot about a second hinge axis extending perpendicular to said first hinge axis to expose said first input interface and a second input interface **only including additional dedicated game pad controls**.

(emphasis added). None of the cited references teach or suggest each and every

element/limitation in Claims 1, 16, 29 and 41. Accordingly, a *prima facie* of obviousness cannot be set forth with the cited references. Accordingly, withdrawal of the rejection and allowance of Claims 1, 16, 29 and 41 is respectfully requested.

#### Dependent Claims

Considering the dependent claims include all of the features of the independent claims from which they depend, the dependent claims are patentable to the extent that the independent claims are patentable. As a result, Applicants respectfully contend that a *prima facie* case of obviousness is not present with respect to the dependent claims for the reasons set forth above with respect to the independent claims.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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